

## REMARKS

Applicant has studied the Office Action dated November 18, 2003 and has made amendments to the claims. No new matter has been added. It is submitted that the application, as amended, is in condition for allowance. By virtue of this amendment, claims 1-17 are pending. Claims 1-17 have been amended. Reconsideration and further examination of the pending claims in view of the above amendments and the following remarks is respectfully requested. In the Office Action, the Examiner:

- Rejected claims 1-8 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.
- Rejected claims 1-17 under 35 U.S.C. § 103(a) as being unpatentable over *McGuire et al* (McGuire) (U. S. PG Pub No. 2003/0023489) in view of *Yamada et al* (Yamada) (U.S. PG Pub No. 2002/0049677).

The Applicant respectfully submits that the Examiner's objection and rejections have been overcome based on the aforementioned amendments to the claims and the following remarks.

### Overview of the Present Invention

The present invention is directed to a method, system and computer readable medium at an electronic digital content store, such as a web site, for associating pieces of advertisement with encrypted digital content that an end user can purchase. The geographic location of the end user receiving the encrypted digital content is determined by either one or both of a geographical address associated with a payment account used to pay for the encrypted digital content or by analysis of network hops along the network path used to communicate with the device used by the end user. Advertisements are selected to be associated with the delivery of encrypted digital content if the address of the end user is determined to be in a predetermined geographic region. In one embodiment, the address verification system includes using the IP address of the end user device, the

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country codes found in the trace routes to the IP address, and the billing address associated with an account used to pay for the requested digital content.

Rejection under 35 U.S.C. §101

As noted above, the Examiner rejected claims 1-8 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicant notes that the Examiner stated that the method recited by the original claims "produces a useful, concrete and tangible result." Office Action dated 11/18/03.

Applicant has also amended independent claims 1, 7 and 8; and dependent claims 2-6, which depend from claim 1, so as to clarify that these claims are directed to "a computer implemented method." Applicant has further amended independent claim 1 to recite that the "associating one or more pieces of advertisement with the encrypted digital content" is performed "on a processor." Applicant asserts that the method defined by the amended claims "apply, involve, use and advance the technological arts" because the method is "a computer implemented method" and includes performing at least part of the method "on a processor. Amended claims 1-8 therefore satisfy both prongs of the statutory subject matter test used by the Examiner. Support for these amendments is found in the specification at, for example, page 34, lines 5-23. No new matter was added by these amendments.

Applicant respectfully asserts that amended claims 1-8 are directed to statutory subject matter and that the Examiner's rejection of these claims under 35 U.S.C. § 101 should be withdrawn.

Rejection under 35 U.S.C. §103(a) as Unpatentable over McGuire in view of Yamada

As noted above, the Examiner rejected claims 1-17 under 35 U.S.C. § 103(a) as being unpatentable over McGuire in view of Yamada. The Examiner recites 35 U.S.C. §103. The Statute expressly requires that obviousness or non-obviousness be determined for the

claimed subject matter "as a whole," and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention "as a whole."

To begin, McGuire is directed to providing targeted advertisements to a user in response to an information request to a content provider node (e.g., a web site) from that user. McGuire, Abstract. An information request in the McGuire reference is generally described as a request for a web page. The description of McGuire allows advertisement to be directed to users who request information from a specific web site or type of website, but a section of a site or a specific page can also be used to select an advertisement to send to the requesting user. McGuire, FIG. 9, paragraphs 53 and 137.

McGuire teaches directing advertisements based upon an estimate of the location of the end user's device. End user's addresses are described as being provided by the end user or by some third party system. McGuire provides no specifics to describe how a user's address can be determined beyond having the user enter the data. McGuire, paragraph 136. The alternative use of a "geolocation service," such as Quova, Inc., is stated but not described. *Id.*

The Yamada reference is directed to an information recording medium on which encrypted information and encrypted keys information are stored. Encrypted information is transmitted to a device for decryption. Yamada, Paragraph 1. The emphasis of the Yamada reference is for the encryption /decryption architecture taught in that disclosure. Applicant has amended the claims of the present invention to more clearly describe how the user's geographical location is determined in one aspect of the present invention. Applicant has amended independent claims 1, 7, 13, 17 to include limitations similar to the following limitations recited for amended claim 1:

accepting an end user request from an end user for delivery of an encrypted digital content;

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charging a payment account for the encrypted digital content;  
determining, using an address verification system during payment  
clearing, a payment clearing address of the end user based upon the  
payment account;  
associating one or more pieces of advertisement with the encrypted  
digital content if the payment clearing address is in a predetermined  
geographic region; and  
delivering, in response to the charging, the encrypted digital content  
and the one or more pieces of the advertisement to the end user.

Dependent claims 11 and 12 have been amended to include similar limitations.

Support for these amendments is found in the specification at, for example, page 37, lines 8-19; page 86, line 23 through page 87, line 16; page 118, lines 14-20; and page 146, line 18 through page 147, line 9.

The cited references, taken either alone or in combination with one another, do not refer to, teach or suggest "charging a payment account for the encrypted digital content; [and] determining, using an address verification system during payment clearing, a payment clearing address of the end user based upon the payment account" as is claimed for these amended claims. Therefore, amended independent claims 1, 7, 13 and 17, and amended dependent claims 11 and 12 distinguish over the cited references for at least this reason. Dependent claims 2-6 depend from claim 1 and include all of the limitations thereof. Therefore dependent claims 2-6 distinguish over the cited references as well.

Applicant has further amended independent claims 8, 9, 14 and dependent claims 10-12 and 15 to more clearly describe the determination of a geographical address of an end user by using another aspect of the present invention. These claims have been amended to include limitations similar to those of amended independent claim 8, which recites:

determining a geographical location of an end user device requesting delivery of encrypted digital content by performing the sub-steps of:

performing a network trace route to the end user device;

querying one or more IP addresses of hops, other than an IP address of the end user device, found in the network trace route in IP databases provided by third parties;

checking one or more country codes for the one or more IP addresses of the hops found in the network trace route; and

determining the geographical location of the end user using preassigned country allocations for class C IP addresses of the one or more IP addresses;

Support for these amendments is found in the specification at, for example, page 80, line 12 through page 87, line 16.

The cited prior art does not teach "determining a geographical location of an end user device" by performing a network trace route to the end user device; querying one or more IP addresses of hops, other than an IP address of the end user device, found in the network trace route in IP databases provided by third parties; checking one or more country codes for the one or more IP addresses of the hops found in the network trace route; and determining the geographical location of the end user using preassigned country allocations for class C IP addresses of the one or more IP addresses" as is claimed by these amended claims.

The McGuire reference teaches determining a location of an end user by reference to a "geolocation service" such as Quova. McGuire, Paragraph 136. The cited references do not teach, anticipate or suggest determining the geographic location of intermediate "hops" found in a network trace. In contrast to the teachings of the cited references, the aspects of the present invention claimed by these amended claims determine an end-user's location by "checking one or more country codes for the one or more IP addresses of"

those intermediate hops, and "using preassigned country allocations for class C IP addresses of the one or more IP addresses" of those hops.

Moreover, the Federal Circuit has consistently held that when a §103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and the *prima facie* case of obviousness can not be properly made. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Here the intent, purpose and function of McGuire is to use a "geolocation service." In contrast, the intent and purpose of the present invention is to use "payment account" information during "payment clearing" as a basis to determine geographical locations of purchasers. Not only does the present invention eliminate the need to have the user enter his/her address, but the present invention makes use of trusted information from a payment clearing system. This modification, as suggested by the Examiner, destroys the intent and purpose of using "geolocation" as used by the McGuire reference. Accordingly, the present invention is distinguishable over McGuire taken alone and/or in view of Yamada for this reason as well.

Continuing further, when there is no suggestion or teaching in the prior art for using "payment account" information during "payment clearing," the suggestion can not come from the Applicant's own specification. As the Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP §2143 and *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and *In re Fitch*, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The prior art reference McGuire does not even suggest, teach nor mention "payment account" information.

For the foregoing reasons, independent claims 1, 7, 13, and 17 as amended distinguish over McGuire taken alone and/or in view of Yamada. Claims 2-6, 8-12, and 14-16 depend from independent claims 1, 7, 13, and 17 respectively, since dependent claims contain all

the limitations of the independent claims, claims 2-6, 8-12, and 14 distinguish over McGuire taken alone and/or Yamada, as well, and the Examiner's rejection should be withdrawn. The Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. §103 should be withdrawn.

### Conclusions

The remaining cited references have been reviewed and are not believed to effect the patentability of the claims as amended.

In this Response, Applicant has amended certain claims. In light of the Office Action, Applicant believes these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicant respectfully submits that the claim amendments do not limit the range of any permissible equivalents.

Applicant acknowledges the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR § 1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment is limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicant and his attorneys.

Applicant respectfully submits that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

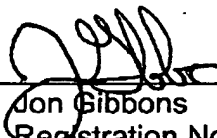


**PLEASE CALL** the undersigned if this would expedite the prosecution of this application.

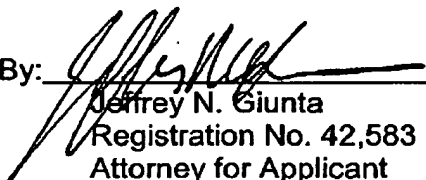
Respectfully submitted,

Date: February 18, 2004

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